

**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

The Examiner is thanked for the courtesies extended during the telephonic interview of March 17, 2007.

**I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1-19 and 22 are currently under consideration. Claim 1 is amended without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicant is entitled.

Support for the amended claim can be found throughout the specification and claims as originally filed. Support for claim 1 can be found, for example, on page 6, line 10 - page 7, line 10, and in Figure 6.

**II. THE REJECTION UNDER 35 U.S.C. § 112 IS OVERCOME**

Claim 9 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particular point out and distinctly claim the subject matter which Applicant regards as the invention. The rejection is respectfully traversed.

Specifically, the Office Action alleges that the recitation of "polyester felt" in claim 9 is unclear because felt is made of wool while a felt-like material is made of polyester. According to the Office Action, it is therefore unclear whether the intended material is wool, polyester-wool blend, or polyester.

In response, it is known in the art that there is a wide subset of felts that are synthetic, and such synthetic felts are exemplified by polyester felts. Polyester felts are commercially available, as evidenced by websites from the Southeastern Felt & Supply Corp. (<http://www.sefelt.com/synthet.htm>; print-out enclosed) and the Sutherland Felt Company (<http://sutherlandfelt.com/poly.htm>; print-out enclosed). Both websites indicate that polyester felts comprise polyester fibers, and Southeaster Felt & Supply Corp. further distinguishes polyester felts from blended felts.

Therefore, it is clear, especially to one skilled in the art, that the material is distinctly disclosed by the recitation of polyester felts. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

### **III. THE REJECTION UNDER DOUBLE PATENTING IS OVERCOME**

Claims 1-4 and 10 were rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claim 5 of U.S. Patent No. 5,955,017 (hereinafter “the ‘017 patent”). This rejection is respectfully traversed.

According to the Office Action, claim 5 of the ‘017 patent teaches the claimed process of making a connected sole and upper of a shoe with the steps of molding a resting surface of a sole and an upper, placing the sole and upper in a mold with the sole against an impression, and removing from the mold after curing of the injected material. The Office Action contends that this process is not patentably distinct from the process of the present invention.

In response, Applicants note that claim 1 is amended herein, such that the first and second blanks are clarified as being “flat;” the method additionally comprises the step of providing a mold comprising a first half and a second half having a three-dimensional impression of the boot part; and the boot part obtained after mold release is clarified as comprising the first and second blanks conformed to the three-dimensional impressions of the boot part.

It is clear that the method of claim 1 is distinct from claim 5 of the ‘017 patent. After release from the mold, the boot part of claim 5 of the ‘017 patent is not comprised of the sole and upper that are conformed to the three-dimensional impressions of the boot part. Rather, the shape and form of the sole and upper are unchanged in the ‘017 patent. This contrasts the present invention, wherein the first and second blanks conform to the shape of the three-dimensional impression of the boot part.

Thus, claim 1 of the present invention, as well as dependent claims 2-4 and 10, discloses a method that is patentably distinct from claim 5 of the '017 patent. Accordingly, reconsideration and withdrawal of the rejection on the grounds of double patenting are respectfully requested.

#### **IV. THE REJECTIONS UNDER 35 U.S.C. § 102(b) ARE OVERCOME**

It is respectfully pointed out that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Bariant Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

##### **§ 102(b) citing Foffano et al.**

Claims 1, 2, 5, 10, and 22 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano et al. (U.S. Patent No. 5,995,017; hereinafter "Foffano"). The Office Action asserts that Foffano teaches a method of making a connected sole and upper of a shoe with the steps of molding a resting surface of a sole from rubber and an upper, placing the sole and upper in a mold with the sole against an impression, closing the mold, injecting polyurethane between the two layers, and removing from the mold after curing of the injected material. This rejection is respectfully traversed.

Applicants reiterate the amendment to claim 1, in particular that the first and second blanks are clarified as being "flat;" the method additionally comprises the step of providing a mold comprising a first half and a second half having a three-dimensional impression of the boot part; and the boot part obtained after mold release is clarified as comprising the first and second blanks conformed to the three-dimensional impressions of the boot part. With this in mind, it is clear that Foffano does not teach each and every element of the instantly claimed invention.

Most notably, Foffano does not teach a boot part comprising the first and second blanks conformed to the three-dimensional impression of the boot part. The Office Action compares the first and second blanks of the present invention with the sole and the bottom face of the upper in

Foffano. However, in Foffano, the sole and the upper do not conform to the three-dimensional impression of the boot part after mold release. As clearly shown in Figs. 5 and 6 in Foffano, the sole and the upper are unchanged in shape and form, and certainly have not conformed to the impression of the boot part. In contrast, the blanks of the present invention do indeed conform to the three-dimensional impression of the boot part.

Therefore it is clear that Foffano does not teach all elements of claim 1 or dependent claims 2, 5, 10, and 22. Reconsideration and withdrawal of the rejection of claims 1, 2, 5, 10, and 22 under 35 U.S.C. § 102(b) are thereby respectfully requested.

**§ 102(b) citing Foffano as evidenced by Smith**

Claims 3 and 4 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Foffano as evidenced by Smith (Textiles in Perspective, page 418). According to the Office Action, the sole in Foffano is vulcanized rubber shaped like a film, i.e., a polymer film, and is considered as a fabric according to Smith. The Office Action also alleges that the sole is elastic. This rejection is respectfully traversed.

In response, Applicant notes that claims 3 and 4 are dependent on claim 1, and therefore have all of the elements of claim 1. As it was established above that Foffano does not anticipate claim 1, Foffano consequently does not anticipate claims 3 or 4. Importantly, Foffano does not teach each and every element of claim 1, and Smith does not remedy this deficiency.

Hence, claims 3 and 4 are not anticipated by Foffano and Smith, and reconsideration and withdrawal of the rejection of claims 3 and 4 under 35 U.S.C. § 102(b) are respectfully requested.

**V. THE REJECTIONS UNDER 35 U.S.C. § 103(a) ARE OVERCOME**

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under §103 is whether the PTO has stated a case of *prima facie* obviousness. “The PTO has the burden under §103 to establish a *prima facie* case of obviousness.” In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P. §706.02(j):

...three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

**§ 103(a) citing Foffano in view of Dassler**

Claim 6 was rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Dassler (U.S. Patent No. 4,187,623). The Office Action contends that Dassler relates to making a sports shoe with a rubber sole thickness of 1.5 to 1.8 mm, and that it would have been obvious to combine Dassler's sole thickness with Foffano's method to develop a lightweight athletic shoe. The rejection is respectfully traversed.

In response, Applicant initially argues that the cited references do not teach or suggest all limitations of claim 6. Applicant notes that claim 6 is dependent on amended claim 1 and thereby encompasses all elements of claim 1. As argued above, it is clear that Foffano does not teach or suggest every element of amended claim 1, as Foffano notably does not teach or suggest a first and second blank that conforms to the three-dimensional impression of the boot part. Rather, the sole and upper of Foffano remain the same shape and form, as shown in Figs. 5 and 6. Dassler does not remedy this deficiency. Thus, the cited references do not teach or suggest all of the limitations of claim 6.

Furthermore, there would not be a reasonable expectation of successfully arriving at the present invention based on the cited references. The Office Action admits that Foffano does not teach the thickness of the rubber sole (first blank) and that Dassler teaches a rubber sole with a thickness of 1.5 to 1.8 mm. This thickness is above the range of material thickness disclosed in claim 6, which recites that the first material has a thickness of 0.8 to 1 mm. A skilled artisan would not arrive at the claim 6 limitation that the first material has a thickness of 0.8 to 1 mm, because the Dassler reference teaches a different thickness. In other words, Dassler actually teaches away from the present invention. With this in mind, one skilled in the art would not successfully arrive at the present invention in view of the teachings of Foffano and Dassler.

Accordingly, reconsideration and withdrawal of the rejection of claim 6 under 35 U.S.C. § 103(a) are respectfully requested.

**§ 103(a) citing Foffano in view of Huebner et al.**

Claims 7 and 9 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Huebner et al. (German Patent Document No. DE 19512499C1; hereinafter “Huebner”). The Office Action asserts that Huebner relates to making a shoe with the upper containing polyester felt at the toe, and that it would have been obvious to combine Huebner’s polyester felt upper with Foffano’s method to attain a shoe with a toe cap able to retain air trapping quality. The rejection is respectfully traversed.

In response, Applicant argues that the cited references do not teach or suggest all limitations of claims 7 and 9. Applicant notes that claims 7 and 9 are dependent on amended claim 1 and thereby encompass all elements of claim 1. To reiterate the arguments above, Foffano clearly does not teach or suggest every element of amended claim 1, as Foffano notably does not teach or suggest a first and second blank that conforms to the three-dimensional impression of the boot part. Rather, the sole and upper of Foffano remain the same shape and form, as shown in Figs. 5 and 6. Moreover, Huebner does not remedy this deficiency. Thus, the cited references do not teach or suggest all of the limitations of claims 7 and 9.

Accordingly, reconsideration and withdrawal of the rejection of claims 7 and 9 under 35 U.S.C. § 103(a) are respectfully requested.

**§ 103(a) citing Foffano in view of Legassie et al.**

Claim 8 was rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Legassie et al. (U.S. Patent No. 5,343,638; hereinafter “Legassie”). According to the Office Action, Legassie relates to using elastic fabric in the upper of a shoe, and it would have been obvious to combine Legassie’s elastic fabric with Foffano’s method to have a lightweight upper that conforms to the contour of the wearer’s foot. The rejection is respectfully traversed.

In response, Applicant argues that the cited references do not teach or suggest all limitations of claim 8. Applicant asserts that claim 8 is dependent on amended claim 1 and thereby encompasses all elements of claim 1. As noted above, it is clear that Foffano does not teach or suggest every element of amended claim 1, as Foffano importantly does not teach or suggest a first and second blank that conforms to the three-dimensional impression of the boot part. Instead, the sole and upper of Foffano remain the same shape and form, as shown in Figs. 5

and 6. Further, Legassie does not remedy this deficiency. Thus, the cited references do not teach or suggest all of the limitations of claim 8.

Accordingly, reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. § 103(a) are respectfully requested.

**§ 103(a) citing Foffano in view of Brehmer et al.**

Claims 11 and 12 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Brehmer et al. (U.S. Patent No. 4,793,882). The Office Action contends that Brehmer relates to screen-printing a part of a shoe upper, and that it would have been obvious to combine the screen-printing of Brehmer with Foffano's method in order to make a shoe with a stiffened upper. The rejection is respectfully traversed.

In response, Applicant argues that the cited references do not teach or suggest all limitations of claims 11 and 12. Applicant asserts that claims 11 and 12 are dependent on amended claim 1 and thereby encompass all elements of claim 1. As noted above, it is clear that Foffano does not teach or suggest every element of amended claim 1, as Foffano notably does not teach or suggest a first and second blank that conforms to the three-dimensional impression of the boot part. Rather, the sole and upper of Foffano remain the same shape and form, as shown in Figs. 5 and 6. Importantly, Brehmer does not remedy this deficiency. Thus, the cited references do not teach or suggest all of the limitations of claims 11 and 12.

Accordingly, reconsideration and withdrawal of the rejection of claims 11 and 12 under 35 U.S.C. § 103(a) are respectfully requested.

**§ 103(a) citing Foffano in view of Perotto '130**

Claims 11, 13-15, and 17 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Perotto (U.S. Patent No. 4,428,130; hereinafter "Perotto '130"). The Office Action asserts that Perotto '130 relates to affixing an eyelet element to a constructed upper before the upper is assembled, and that it would have been obvious to combine Perotto '130 and Foffano in order to make a shoe having an eyelet to thread a tightening strip. The Office Action further alleges that Perotto '130 mentions a flap that overlies a cutout of the upper, and that it would have been obvious to combine Perotto '130 and Foffano in order to make a shoe having a flap to seal the cutout in the upper. The rejection is respectfully traversed.

In response, Applicant argues that the cited references do not teach or suggest all limitations of claims 11, 13-15, and 17. Applicant notes that claims 11, 13-15, and 17 are

dependent on amended claim 1 and thereby encompass all elements of claim 1. It is clear that Foffano does not teach or suggest every element of amended claim 1, as Foffano importantly does not teach or suggest a first and second blank that conforms to the three-dimensional impression of the boot part. Rather, the sole and upper of Foffano remain the same shape and form, as shown in Figs. 5 and 6. Significantly, Perotto '130 does not remedy this deficiency. Thus, the cited references do not teach all of the limitations of claims 11, 13-15, and 17.

Accordingly, reconsideration and withdrawal of the rejection of claims 11, 13-15, and 17 under 35 U.S.C. § 103(a) are respectfully requested.

**§ 103(a) citing Foffano in view of Perotto '319**

Claims 11, 16, and 19 were rejected under § 103(a) as allegedly being unpatentable over Foffano in view of Perotto (U.S. Patent No. 5,050,319; hereinafter "Perotto '319"). According to the Office Action, Perotto '319 relates to attaching a tongue to an inner lining which provides closure on the front of the shoe part, and it would have been obvious to combine Perotto '319 and Foffano in order to make a shoe having a tongue that spread the clamping pressure exerted by the buckles on the boot. The rejection is respectfully traversed.

In response, Applicant argues that the cited references do not teach or suggest all limitations of claims 11, 16, and 19. Applicant asserts that claims 11, 16, and 19 are dependent on amended claim 1 and thereby encompass all elements of claim 1. As noted above, it is clear that Foffano does not teach or suggest every element of amended claim 1, as Foffano importantly does not teach or suggest a first and second blank that conforms to the three-dimensional impression of the boot part. Instead, the sole and upper of Foffano remain the same shape and form, as shown in Figs. 5 and 6. Moreover, Perotto '319 does not remedy this deficiency. Thus, the cited references do not teach or suggest all of the limitations of claims 11, 16, and 19.

Accordingly, reconsideration and withdrawal of the rejection of claims 11, 16, and 19 under 35 U.S.C. § 103(a) are respectfully requested.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:

  
Ronald S. Santucci  
Reg. No. 28,988  
Telephone: (212) 588-0800  
Facsimile: (212) 588-0500

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2870 Armentrout Dr.  
Concord, NC 28026 USA  
Tel: 704.782.7952  
Fax: 704.782.7410

[info@sefelt.com](mailto:info@sefelt.com)

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## Felts, Plushes, Velvets & Blends

### Polyester

Southeastern offers converted polyester products ranging from 1/16" to 1 1/2" thick. Distinguishing features include:

- Withstands temperatures from 200° F to 550° F.
- Outstanding mildew resistance
- Unaffected by aging
- Good chemical resistance including high tolerance to bleach

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**Typical Applications:** Air filters, impregnated substrates, seals, wicks, moisture pads, metal wiping, liquid filtration, and gaskets.

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### 50/50 Wool-Polyester

Wool and polyester fibers are blended together then needle punched to form a product similar to SAE felts. Additional properties are obtained and it is very economical.

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**Typical Applications:** Gaskets, wicks, dust shields, oil & grease containers, bumpers, bearing seals, ink rolls, dryer drum seals, and padding.

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### Plushes

Pile fabrics are a combination of natural & synthetic fibers. A wide variety of pile types, height, and configurations is available.

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**Typical Applications:** Gaskets, wipers, light seals, roll covers, lint brushes, directional belts, litho plate cleaners, etc.

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### Grip Tape

A unique non slip covering for textile and other rolls. This plush material impregnated with a rubber-like compound provides outstanding traction ability. Available in lengths ranging from 200 to 250 feet, and in standard widths of 2", 3", and 56". Two grades are available.

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**Typical Applications:** Textile roll covers.



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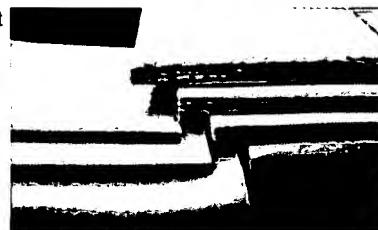
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### **Polyester Felt**

Polyester felt is a synthetic needle punched felt made from polyester fibers. This general purpose felt is made in various densities with thicknesses ranging from .019" to 2". Polyester felt is fairly inexpensive, and often made in comparable density and thickness to SAE pressed wool felt. The maximum temperature of polyester felt is 300 degree F., compared to 200 degrees for SAE pressed felts. This material is commonly used for filtration applications, gaskets, wipers, and padding in a wide variety of industries. The density of polyester felt is commonly measured in ounces/per Sq. yard. Sutherland can custom manufacture this material to virtually any density.



### **Check out our current polyester felt specials!!**

**White Polyester, 32 Oz./Sq. Yd, 1/8" thick, 72" wide.....\$9.90 Per Yd**

**White Polyester, 48 Oz./Sq. Yd, 1/4" thick, 72" wide.....\$17.95 Per Yd**

**White Polyester, 64 Oz./Sq. Yd, 1/4" thick, 72" wide.....\$18.65 Per Yd**



### **Commonly Stocked Polyester Felt**

Product	Thickness	Weight (Oz. Per Sq. Yd.)	Roll Width
White Polyester Felt	1/16"	11 Oz.	64"
Polyester Felt w/Scrim	1/16"	16 Oz.	72"
White Polyester Felt w/PSA	1/8"	18 Oz.	54"
White Polyester Felt	1/8"	32 Oz.	72"
White Polyester Felt	3/16"	48 Oz.	72"
White Polyester Felt w/PSA	1/4"	24 Oz.	54"
White Polyester Felt	1/4"	32 Oz.	50"
White Polyester Felt	1/4"	48 Oz.	72"
White Polyester Felt w/PSA	1/4"	48 Oz.	36"
White Polyester Felt	1/4"	64 Oz.	72"
White Polyester Felt	5/16"	78 Oz.	72"
White Polyester Felt w/PSA	1/4"	64 Oz.	36"
White Polyester Felt	3/8"	85 Oz.	72"
White Polyester Felt	7/8"	60 Oz.	72"

Special Orders normally require a 3-4 week lead time and a manufacturing minimum. Items designated as in-stock are normally inventoried, but may occasionally be in the process of being produced, thus requiring a 3-4 week lead.

### **Sheet Felt**

Sheet felt is a dense, pressed wool product that is manufactured in 36" X 36" sheets. Sutherland

makes this product anywhere from 1/8" to 2-1/2" thick. This is a very dense felt; thus it cannot made in roll form. Densities range from 22 Lbs./Sq. Yd to 40 Lbs. (@1" thick), per sq. yd, with 26 Lb. & 32 Lb. being the standards. Sutherland Felt Co. is a leading manufacturer of sheet felt squeegees for the automotive, sign, and print industry.

**Commonly Stocked Sheet Felt:**

**Stock = In Stock**  
**S/O = Special Order**

Product	1/8"	3/16"	1/4"	3/8"	1/2"	5/8"	3/4"	1"	1-3"
<b>26 Lb</b>	stock	S/O	stock	stock	stock	stock	stock	S/O	S/O
<b>32 Lb</b>	S/O	S/O	S/O	S/O	stock	stock	stock	S/O	S/O

Special Orders normally require a 3-4 week lead time and a manufacturing minimum. Items designated as in-stock are normally inventoried, but may occasionally be in the process of being produced, thus requiring a 3-4 week lead.

**Felt Material:** Pressed Wool Felt | Polyester Felt & Sheet Felt | Needle Punched & Anti-Squeak | Felt Wicking / Stripping / Adhesive Backed Felt  
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